



PATENT: Mail Stop AF

Customer No. 22,852
Attorney Docket No. 05225.0185

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Takafumi WATANABE) Group Art Unit: 2132
Application No.: 09/498,995) Examiner: KIM, Jung W.
Filed: February 7, 2000)
For: PORTABLE ELECTRONIC) Confirmation No.: 9593
DEVICE WITH A SECURITY)
FUNCTION AND A)
NONVOLATILE MEMORY (as)
amended))

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Final Office Action mailed on August 19, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005, and a Petition for Extension of Time.

Remarks follow in the next section of this paper.

REMARKS

Applicant requests a pre-appeal brief review of rejections set forth in the Final Office Action of August 19, 2005. Such a review is proper because (1) the application has been at least twice rejected; (2) Applicant has concurrently filed a Notice of Appeal (prior to filing an Appeal Brief); and (3) this Pre-Appeal Brief Request for Review is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections.

See Official Gazette Notice, July 12, 2005.

Claims 8-17 are pending in this application. In the Final Office Action, the Examiner rejected claim 8 under 35 U.S.C. § 112, first paragraph; rejected claims 8-11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Iijima (U.S. Patent No. 5,365,045); rejected claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Chapters 2 and 24 of *Applied Cryptography* by Schneier; and rejected claims 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Grimonprez et al. (U.S. Patent No. 5,473,690).

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant notes that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure, coupled with information known in the art, without undue experimentation. See MPEP § 2164.01. Claim 8 meets this requirement.

For example, Applicant's specification at page 5, lines 16-24 discloses that "IC card 102 comprises a reading/writing unit 200 ... and a supervisor 205. Supervisor 206 controls various functions executed by units 200, 202, and 204." Furthermore, page 6, lines 4-10 discloses that "[s]upervisor 206 receives a command (and data) from card reader/writer 106, interprets that command, and instructs units 200, 2002, and 204 to

execute various functions, such as read, write, encode, or decode." Page 8, lines 9-13 disclose, among other things, that "[s]ecurity flag 506 is set while security of an application is valid." Finally, page 10, lines 10-19 discloses an example of a command message being processed. Claim 8 is enabled by at least these portions of the specification such that one skilled in the art could make or use the invention without undue experimentation. Accordingly, the rejection of claim 8 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

Applicant respectfully traverses the rejection of claims 8-11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Iijima and submit that a clear error exists in the Examiner's rejection. The rejection cannot stand because Iijima does not teach at least "first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include the *validity data for the security function* and the second determining means determines the validity data is not stored in the nonvolatile memory," as recited in claim 8 (emphasis added).

During examination, the words of a claim should be interpreted consistent with the "broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." See MPEP § 2111. In rejecting claim 8, the Examiner has not construed the claimed "security function" consistent with Applicants' specification; nor has the Examiner construed this claim recitation consistent with how the words would be understood by one of ordinary skill in the art.

For example, Applicant's specification describes a "security function" in a manner that is exemplary of the meaning one of ordinary skill in the art would afford to the term. In particular, the specification provides as follows:

A portable electronic device ... prevents an unauthorized third person from reading and rewriting data stored in an internal memory ... or writing new data into the internal memory by a security function.

See page 1, lines 9-13.

According to Iijima, DF (data file) definition command data is used to check whether a memory cell has malfunctioned. See col. 5, lines 64 to col. 6, lines 18. However, the Examiner contends Iijima teaches the claimed "security function" because "detecting abnormalities of a memory is within the boundaries of a check to a security function." See Advisory Action, page 2. Applicant respectfully disagrees.

The Examiner has correlated detection of a memory abnormality with the claimed "security function." Such a correlation, however, is misplaced in view of the meaning of a "security function" that would be understood by one of ordinary skill in the art and that is supported by Applicant's specification. One of ordinary skill in the art would understand a security function to prevent or provide access to a memory, not to determine whether the memory is error free. Since detecting a memory abnormality or malfunction does not constitute the claimed "security function," Iijima does not teach all of the elements of claim 8. Accordingly, the rejection of claim 8, and dependent claims 9-11 and 13, which depend from claim 8, should be withdrawn.

Applicant respectfully traverses the rejection of claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Chapters 2 and 24 of *Applied Cryptography* by Schneier and the rejection of claims 15-17 under 35 U.S.C. § 103(a)

as being unpatentable over Iijima in view of Grimonprez. Claims 12 and 14-17 depend indirectly from allowable claim 8. Since Schneier and Grimonprez do not cure the deficiency of Iijima, that is, do not disclose or suggest at least "first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include the validity data for the security function and the second determining means determines the validity data is not stored in the nonvolatile memory," as recited in claim 8 and required by claims 12 and 14-17, claims 12 and 14-17 are also allowable over the applied references at least due to their dependence from claim 8.

CONCLUSION

In view of the foregoing, Applicants respectfully request a pre-appeal brief review of the rejections in the Final Office Action mailed on August 19, 2005. Pending claims 8-17 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 13, 2006

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